



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/484,337 06/07/90 BREWER

18N2/1002

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EXAMINER	
ART UNIT	PAPER NUMBER
DRAPER, G	

1812
DATE MAILED:

10/02/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

For restriction only
☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire _____ month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-848. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-21 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☐ Claims _____ are rejected.

5. ☐ Claims _____ are objected to.

6. ☒ Claims 1-21 are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Art Unit: 1812

1. A telephone call was made to Thomas Zindrick on 9-24-96 and 9-30-96 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicants have indicated that they are not able to elect by telephone at this time because of the uncertainty of which group to choose. This is because one of their other applications has gone abandoned and they are trying to revive. In that application claims to the protein were being examined. The outcome of whether this application will be revived will determine which group is elected herein. Base on the above, a written restriction is being issued in the interest of time.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, drawn to a TNF inhibitor, classified in class 530, subclass 350.
- II. Claims 12-21, drawn to a recombinant method of making a TNF inhibitor and the gene that encodes such, classified in classes 435 and 536, subclass 69.1 and 23.5 respectively

The inventions are distinct, each from the other because:

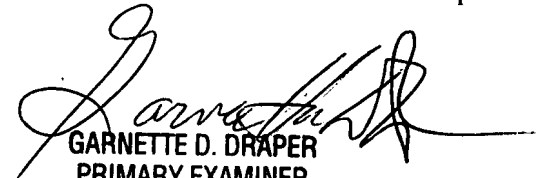
Inventions of Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the protein can be prepared by a materially different process such as by isolation from nature using various isolation/purification/chromatographic procedures; or the protein can be prepared by chemical synthesis. Furthermore, the products of these two group (e.g. the protein and the DNA) are physically, functionally and patentably distinct, and if determined to be patentable they would be patentably distinct. The DNA can also be used other than to make the protein of Group I such as it's use as a probe or in gene therapy.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, which are not co-extensive, thus restriction for examination purposes as indicated is proper.

Art Unit:

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

3. Any inquiry concerning this communication should be directed to Garnette D. Draper at telephone number (703) 308-4232.



GARNETTE D. DRAPER
PRIMARY EXAMINER
GROUP 1800